

### **REMARKS**

Claims 1-3, 7, 22-25, 35, and 49 are amended and claims 79-86 are added. Claims 1-75 and 79-86 are now pending in this application. The amendments to the claims are supported by the application as filed, and no new matter has been added.

Claims 7 and 25 are amended to correct typographical errors.

The amendments to claims 1-3, 22-24, 35, and 49 are supported by the specification as filed, for example, at page 10, lines 13-16.

New claims 79-80 are supported by the specification as filed, for example, at page 15, lines 14-15.

New claims 81-82 are supported by the specification as filed, for example, at page 15, lines 16-17.

New claims 83-86 are supported by the specification as filed, for example, by the Examples portion of the specification and by originally-filed claims 22-24.

#### **I. The Restriction Requirement**

Claims 58-75 were subjected to a restriction requirement and withdrawn from consideration by the Examiner in the Office Action mailed November 23, 2001. That restriction requirement is respectfully traversed.

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct and independent inventions. M.P.E.P. § 803. The Examiner has examined claims 1-57. Claims 58-75 are dependent claims that depend from claims 1, 2, 3, 22, 23, 24, 35 and/or 49. It is respectfully submitted that the search and examination of claims 58-75 would not place an additional burden on the Examiner. Thus, the Examiner is respectfully requested to withdraw the Restriction Requirement.

Additionally, in order to establish that combination and sub-combination inventions are distinct, two-way distinctness must be demonstrated; the burden is on the Examiner to provide an example of separate utility. M.P.E.P. §806.05(c). In the Office Action mailed November 23, 2001, the Examiner stated "The sub-combination has separate utility in other combinations." It is respectfully submitted that the Examiner's statement is not sufficient to meet the Examiner's

burden. There is no utility identified in this statement. Applicant requests that the Examiner identify what "other combinations" are intended, and what such "other combinations" would be useful for. Without this information, Applicant respectfully submits that the restriction requirement is improper and should be withdrawn.

Finally, if the Examiner maintains the Restriction Requirement and the elected claims are found to be patentable, Applicant requests that the Restriction Requirement be withdrawn and that claims 58-75 be examined.

## II. The 35 U.S.C. § 112(1) Rejection

In the Decision mailed February 23, 2005, the Board of Patent Appeals and Interferences (hereinafter the BPAI) entered a new ground of rejection, alleging that claims 1-57 do not comply with the written description requirement of 35 U.S.C. § 112, first paragraph. Specifically, the Examiner alleges that all of the claims require the presence or use of an "organic compound" defined only by way of a functional statement. As this rejection may be applied to the pending claims, it is respectfully traversed.

The Examiner is respectfully requested to note that in the Decision, the BPAI stated that "[w]hile the specification sets forth a number of compounds stated to possess the claimed function, those compounds are strictly limited to those containing either a carbon-selenium bond or a carbon-sulfur bond" (page 5, lines 19-22). The BPAI also stated in the Decision that Applicants have provided "a description of compounds that comprise a carbon-sulfur bond or a carbon-selenium bond" (page 3, lines 16-17).

The pending claims have been amended to recite that the organic compounds have at least one carbon-sulfur single bond (C-S), carbon-sulfur double bond (C=S), or carbon-selenium double bond (C=Se). Thus, Applicant respectfully submits that the pending claims conform to the requirements of 35 U.S.C. § 112, first paragraph, and so withdrawal of the 35 U.S.C. § 112, first paragraph, rejection is respectfully requested.

III. The 35 U.S.C. § 103(a) Rejections of the Claims

In the Decision mailed February 23, 2005, the BPAI vacated all of the pending rejections of the claims under 35 U.S.C. § 103(a). It is respectfully submitted that the pending claims meet the requirements of 35 U.S.C. § 103(a).

CONCLUSION

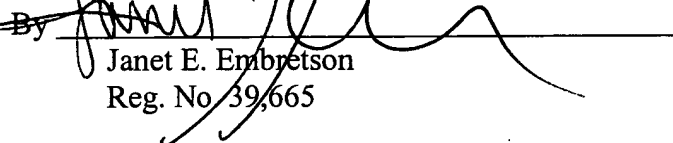
Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6959 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,  
ERIKA HAWKINS ET AL.  
By their Representatives,

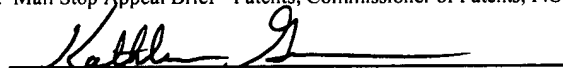
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Date April 22, 2005

By   
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22 day of April, 2005.

KATHLEEN GANNON



Name

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